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Act 1911

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C O N T E N T S.

Legal Department, File No. G. Patents/52.

Sr. No.	Compilation No.	Subject.	Pages.
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Opinions under the Patents and Designs Act, 1911.

1. O.No. 5755/17-4-52.

Re: Manufacture of Sulphathiazole under Patent No. 29093 by the Haffkine Institute.
May & Baker of Exco are also the holder of Indian Patent No. 26513. Question whether the manufacture of sulphathiazole of the Haffkine Institute infringe M/s. May & Baker Patent.

1-8.

2. O.No. 9497/7-6-52.
turns to Indian Govt.
R.I.No. 13616/9-7-52
(Adv. Gen.'s opinion
No. 112. 8-7-52
O.No. 11329/12-7-52.

Infringement
Re: Impliment-~~pf~~ patent hold by M/s. May & Baker.

9-21.

Dr
917

The Haffkins Institute, Parel, is manufacturing Sulphathiazole under Patent No. 29093 standing in the name of the Director of the Institute. Messrs. May & Baker Ltd., of Essex are also the holder of earlier Indian Patent No. 26513 which they got amended recently under the circumstances referred to herein after. Messrs. May & Baker consider that the manufacture of Sulphathiazole at the Haffkins Institute constitutes an infringement of their Patent No. 26513 as amended. They therefore proposed to the Haffkins Institute that the latter should obtain a license from them on payment of royalty. The Haffkins Institute has denied the allegation and correspondence has gone on between the two patentees since 1948. In their letter dated 19th April 1951, Messrs. May & Baker have contended that the proposed amendment of their patent was advertised in the normal way and the Haffkins Institute could have opposed the amendment. In reply the Director of the Haffkins Institute proposed to write to Messrs. May & Baker as in the draft letter at pp. 23-25 ante. The Director of Haffkins Institute desires that the legal position ^{of} ~~be~~ be examined before a reply is sent to Messrs. May & Baker.

2. In their letter No. PAT/ADHS/JDB/4754, dated the 19-4-1951 to the Director of the Haffkins Institute, Messrs. May & Baker have raised the following points:-

- (1) That the amendment of their Patent No. 26513 made during the course of the proceedings in the High Court had been advertised in the normal way and that the amendments allowed are therefore valid and are not open to challenge; and
- (2) That the process described in Haffkins Institute's Patent No. 29093 constitutes an infringement of their own Patent No. 26513.

3. The full history of the manufacture of sulphathiazole by Messrs. May & Baker both in England and in this country and of the Patents held by them will be found in Shri K. Ganapathi's D.G. Letter dated the 13th April 1950. In 1946 Messrs. Boots Pure Drug Co. (India) Ltd., imported into India some sulphathiazole from England for sale in India. Thereupon an action for the infringement of their Patent was commenced by Messrs. May & Baker. The Defendants Messrs. Boots Pure Drug Co., counterclaimed for the revocation of the Patent. In the proceedings Messrs. May & Baker applied for amendment of their Patent restricting their invention only to sulphathiazole and deleting reference to all other compounds for which in similar proceedings commenced in England ~~the~~ the English patent was held "bad for want of subject matter since the claim covered thousands of compounds most of which were therapeutically not useful and the invention was not a manner of new manufacture."

Judgement of the English courts in the litigation between Messrs. May & Baker Ltd., and Messrs Boots Pure Drug Co. (India) Ltd. are put up at slips D.E.&F. A brief containing the pleadings in the Calcutta suit between the same parties is put up at slip G. The application for amendment appears ^{at} slip H. ~~The~~ Pending the proceedings an understanding was arrived at between Messrs. May & Baker and Messrs. Boots Pure Drug Co. As a result the application to amend was not opposed and was allowed (vide Justice Chatterjee's judgement dated 15-3-1949). Messrs. May & Baker contend that the application for amendment was duly advertised and the Haffkine Institute could have lodged opposition in the Court if they wished. It appears, however, that even the Patents Office of the Government of India is not aware as to when and where the amendments were advertised. According to the procedure existing in the United Kingdom such amendments are normally advertised

in the Official Journal of the Patent Office. No directions as to advertisement from the Court were received by the Patent Office. It does not appear that any notice of amendment was served upon the Controller as provided in section 18 of the Indian Patents and Designs Act, 1911. However, it appears that under section 18 advertisement is a discretionary matter for the Court and as regards this the Controller has not made any grievance in that behalf. It will, therefore, be difficult for the Haffkine Institute to challenge the amendment on either of those grounds.

4. The next point raised is about infringement. Infringement is a question both of law and facts. So far as the general principles of law are concerned, it has been held that if any person has taken the "pitch and marrow" of a patented invention, the mere fact that he has improved ~~down~~ upon it and taken a subsequent patent upon the improvement does not negative infringement. It would be a fallacy to assume that there is no infringement because an article possesses advantages over a patented article. *mat later Patent is not a decisive matter for the purpose of* The fact that the article is subject of a deciding the question of infringement. The question to be considered is whether the alleged infringement article embodies the "substance" of the invention claimed by the patentee. To determine this question, it will be necessary to construe the specification on which the patentee has been granted a patent and particularly the claims therein. Under section 3(3) of the Patents and Designs Act, 1911 an applicant for a patent has to declare that he is in possession of an invention whereof he claims to be the true and first inventor for which he desires to obtain a patent. The expression 'invention' means any manner of new manufacture and includes an improvements and an alleged invention. (See section 2(6)). Though Messrs. May & Baker Ltd. were holding an earlier patent No. 25513,

the Haffkine Institute was also granted a patent for the manufacture of sulphathiazole. The application of the Haffkine Institute for the grant of a patent does not seem to have been opposed by Messrs. May & Baker Ltd., probably because the manner of manufacture of the drug by the Institute was different from that of Messrs. May & Baker Ltd., If as stated by the Director of the Haffkine Institute the drug is manufactured at the Institute only in accordance with the process covered by patent No. 29095 which is different from that granted to Messrs. May & Baker Ltd., there would not appear to be any infringement of the latter.

5. Having regard to the difficulties involved, it would be advisable to accept a licence from Messrs. May & Baker Ltd. at a nominal Royalty of Rs.1/- as now proposed by them.

Sd. J.R. Dhurandhar.
17/4

O.O.

Additional Secretary to Government.

U.R. to L.S.O.&P.H.D.No.8735 dated the 17th April 1952.

VGP. 15-6-55.

Statement of the Case.

The Haffkine Institute, Farel, is manufacturing Sulphathiazole under Patent No. 29093 standing in the name of the Director of the Institute. Messrs. May & Baker Ltd., of Essex are also the holder of earlier Indian Patent No. 26513 which they got amended recently under the circumstances referred to hereinafter. Messrs. May & Baker consider that the manufacture of Sulphathiazole at the Haffkine Institute constitutes an infringement of their Patent No. 26513 as amended. They therefore proposed to the Haffkine Institute that the latter should obtain a licence from them on payment of royalty. The Haffkine Institute has denied the allegation and correspondence has gone on between the two patentees since 1948. In their letter dated 19th April 1951, Messrs May & Baker have contented that the proposed amendment of their patent was advertised in the normal way and the Haffkine Institute could have opposed the amendment. In reply the Director of the Haffkine Institute proposed to write to Messrs. May & Baker as in the draft letter at pages 23-25 ante. The Director of Haffkine Institute ~~proposes to write to Messrs. May & Baker as in the draft letter at pages 23-25 ante.~~ desires that the legal position be examined before a reply is sent to Messrs. May & Baker.

2. In their letter No. PAT/ADHS/JDB/4554, dated 19-8.1951, to the Director of the Haffkine Institute, Messrs, May & Baker have raised the following points :-

- (1) That the amendment of their Patent No. 16513 made during the course of the proceedings in the High Court had been advertised in the normal way and that the amendments allowed are therefore valid and are not open to challenge; and
- (2) That the process described in Haffkine Institute's Patent No. 22093 constitutes an infringement of their own Patent No. 26513.

3. The full history of the manufacture of sulphathiazole

By Messrs. May & Baker both in England and in this country and of the Patents held by them will be found in Shri K. Ganpathi's D.O. letter dated the 13th April 1950. In 1946 Messrs. May Boots Pure Drug Co. (India) Ltd., imported into India some sulphathiazole from England for sale in India. Thereupon an action for the infringement of their Patent was commenced by Messrs. May & Baker. The Defendants Messrs. Boots Pure Drug Co. counterclaimed for the revocation of the Patent. In the proceedings Messrs. May & Baker applied for amendment of their Patent restricting their invention only to sulphathiazole and deleting reference to all other compounds for which in similar proceedings commenced in England the English patent was held "bad for want of subject matter since the claim covered thousands of compounds most of which were therapeutically not useful and the invention was not a manner of new manufacture."

Judgements of the English courts in the litigation between Messrs. May & Baker Ltd., and Messrs. Boots Pure Drug Co. (India) Ltd are put up at slips D.E.&F. A brief containing the pleadings in the Calcutta suit between the same parties is put up at slip G. The application for amendment appears at slip H. Pending the proceedings an understanding was arrived at between Messrs. May & Baker and Messrs. Boots Pure Drug Co. (India) Ltd. As a result the application to amend was not opposed and was allowed (vide Justice Chatterjee's judgement dated 15-3-1949). Messrs. May & Baker contend that the application for amendment was duly advertised and the Haffkine Institute could have lodged opposition in the Court if they wished. It appears, however, that even the Patent Office of the Government of India is not aware as to when and where the amendments were advertised. According to the procedure existing in the United Kingdom such amendments are normally advertised in the Official Journal of the Patent Office. No directions as to advertisement from the Court were received by the Patent Office. It does not appear that any notice of amendment was served upon the Controller as

provided in section 18 of the Indian Patents and Designs Act, 1911. However, it appears that under section 18 advertisement is a discretionary matter for the Court and as regards this the Controller ^{he} ~~has~~ not made any grievance in that behalf. It will, therefore, be difficult for the Haffkine Institute to challenge the amendment on either of those grounds.

4. ~~The~~ next point raised is about infringement. Infringement is a question both of law and facts. So far as the general principles of law are concerned, it has been held that ~~if xxx~~ any person has taken the "pith and marrow" of a patented invention, the mere fact that he has improved upon it and taken a subsequent patent upon the improvement does not negative infringement. It would be a fallacy to assume that there is no infringement because an article possesses advantages over a patented article. The fact that the article is subject of a later patent is not a decisive matter for the purpose of deciding the question of infringement. The question to be considered is whether the alleged infringement article embodies the "substance" of the invention claimed by the patentee. To determine this question, it will be necessary to construe the specification on which the patentee has been granted a patent and particularly the claims therein. Under section 3(3) of the Patents and Designs Act, 1911, an applicant for a patent has to declare that he is in possession of an invention whereof he claims to be the true and first inventor for which he desires to obtain a patent. The expression 'invention' means any manner of new manufacture and includes an improvement and an alleged invention. (See section 2(3)). ^{Though} Messrs. May & Baker Ltd. were holding an earlier patent No 26513, the Haffkine Institute was also granted a patent for the manufacture of sulphathiazole. The application of the Haffkine Institute for the grant of a patent does not seem to have been opposed by Messrs. May & Baker Ltd., probably because the manner of manufacture of the drug by the

Institute was different from that of Messrs. May & Baker Ltd. If as stated by the Director of the Haffkine Institute the drug is manufactured at the Institute only in accordance with the process covered by patent No. 29093 which is different from that granted to Messrs. May & Baker Ltd., there would not appear to be any infringement of the latter.

5. Messrs. May & Baker have now offered to grant to licence in favour of the Haffkine Institute on the payment of a nominal royalty of rupee one. As however the acceptance of a licence from Messrs. May & Baker would amount to the Haffkine Institute giving up its claim that its patent does not infringe the patent granted to Messrs. May and Baker ^{and as the acceptance of the proposal now made by Messrs May & Baker} would affect the future plans of the Institute, it is necessary to ascertain whether the manufacture of sulphathiazole at the Haffkine Institute can at all be said to be in infringement of the patent held by Messrs. May and Baker. As the matter is of great importance the Advocate General is kindly requested to express his opinion.

Sd. J.R.Dhurandhar.

G.O.

Additional Secretary to Government.

U.R. to Advocate General, Bombay, No. 9497, dated the 7th June 1952.

VGP. 19-5-56.

Advocate General's Chambers,

High Court,

Bombay, July 8, 1952.

U.R. TO ADVOCATE GENERAL

BOMBAY NO. 9497 DT. 7/8/52.

In this case two questions arise for consideration. (1) Whether the amendment of Patent No. 26513 issued to May & Baker Ltd. in pursuance of the order of the Calcutta High Court has any effect on the Patent No. 29093 issued to the Haffkine Institute (II) Whether the Haffkine Institute Patent No. 29093 constitutes an infringement of Patent No. 26513 issued to May & Baker Ltd.

As regards the first question, the facts as set out in the statement of the case, are governed by s. 18 of the Indian Patents and Designs Act (II of 1911). The amendment of the specification of May & Baker patent has been allowed by the Calcutta High Court under this section and the advertisement of the proposed amendment is to be on such terms as the court may think fit. The fact that the proposed amendment was not advertised in the usual manner, namely, by advertisement in the official journal of the Patent Office cannot affect the validity of the amendment. The fact that at the stage when the amendment was allowed by the High Court the proceedings were ex-parte, also does not affect the validity of the amendment and for all purposes it must be considered that the specification for patent No. 26513 has been -- validly amended.

The next question that arises is whether Haffkine Institute Patent No. 29093 constitutes an infringement of Patent No. 26513. One thing that should be clearly borne in mind is that after the date of the amendment of specification by May & Baker Ltd., it is the amended specification which will apply and the question of infringement will have to be considered in the light of these amended specifications.

The position in law as to infringement of patents is clear:-

The consideration of the question of infringement is simplified if one remembers that inventions may be divided roughly into two classes. Firstly, there is the kind of invention-

invention which consists in the discovery of a method of application of a new principle --here what has been invented is in effect the new principle and generally speaking, the Court will regard jealously any other method embodying that principle, because the inventor was not bound to describe every method by which his invention could be carried into effect. That is to say, where the claim is for a method of attaining a new result, the novelty of the result itself is part of the consideration given by the inventor for the grant of his monopoly; and a defendant will be held to have infringed if he has arrived at the same result by means substantially the same as, or only colourably different from, those claimed by the inventor.

Secondly, there is the kind of invention which consists in some particular new methods of applying a well-known principle, and in this case the use of other methods is not contemplated by the inventor, and should not be included within the ^{ambit} of his claim. That is to say, where the claim is merely for an improved mode of attaining an old subject, the monopoly is for that particular improvement, and a defendant will only be held to have infringed if he made use of that particular method. (Terrell on Patents 8th Ed. p.153)

If a defendant has taken the "pith and marrow" of an invention the fact that he has improved upon it is immaterial; he has nevertheless infringed. It is a very common mistake to assume that there is no infringement because an article presents advantages over the patented article, and is perhaps itself the subject of a later patent taken out by the defendant. The fact that the article is the subject of a later patent is not, however, material, as the question is whether the article made or the process used embodies the invention claimed by the plaintiff. In *Wenham, Gas Co. vs. Champion Gas Co.* (2R.F.C. 49 (C.A.) at p-56) Bowen, L.J. said; "there being no real objection to the way in which it (i.e. the invention) is claimed if the pith and marrow of the invention is taken it is no excuse to say that you have

you have added something, or omitted something, even if the addition or omission be useful and valuable. The superadding of ingenuity to a robbery does not make the operation justifiable." (Terrell on Patents 8th Ed. p-158).

In the light of the facts set out by Shri. K. Ganpathi in his note dated 13th April 1950, and the facts pointed out by Messrs Boots Pure Drug Co. (India) Ltd. in their particulars of objections in the Calcutta suit, it is clear that M/S May & Baker's Patent No. 26513 even after the amendment refers to a particular new method of a principle which was previously well known and does not refer to a new principle. That being so, as the process of manufacture of Sulphathiazole by the Haffkine Institute is another method altogether from the method employed by M/S. May & Baker Ltd. in their manufacture of the same product as set out in the amended specifications there cannot be any infringement of patent No. 26513 (as amended) by Haffkine's Patent No. 29093. In coming to this conclusion I have relied on the facts and technical data as set out in Shri Ganapathi's note.

It may be noted that M/S May & Baker Ltd., seem to have mildly opposed the application of the Haffkine Institute before Patent No. 29093 was issued to the Institute and that as the result of such opposition the specifications of Haffkine Institute's patent contain reference to patents Nos. 26513 and 26880 which had been previously issued to M/S May & Baker Ltd. The question of infringement is a question mostly of fact and will not be affected by absence or presence of such opposition. The real question is whether the process of the Haffkine Institute takes away the "pitch and marrow" of the specifications of M/S May & Baker patent. As observed above, on the facts as stated by Shri. Ganapathi this question of facts can be answered in favour of the Haffkine Institute.

Under the circumstances I am of opinion that the Patent No. 29093 does not constitute an infringement of Patent No. 26513.

Sd.

Advocate General of Bombay.

A copy of the Advocate General's opinion together with a copy of the Statement of the Case is sent herewith.

Sd. J.R.Dhurandhar,
10/7

O.C.

Additional Secretary to Government.

U.R. to L.S.G.& P.H.D.No.11529 dated 12th July 1952.

VGP. 19-6-56.